



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,708	09/19/2001	Gerald R. Crabtree	STAN201	4284

24353 7590 07/31/2003

BOZICEVIC, FIELD & FRANCIS LLP
200 MIDDLEFIELD RD
SUITE 200
MENLO PARK, CA 94025

EXAMINER

MCGARRY, SEAN

ART UNIT	PAPER NUMBER
----------	--------------

1635

DATE MAILED: 07/31/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/960,708

Applicant(s)

CRABTREE ET AL.

Examiner

Sean R McGarry

Art Unit

1635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-29 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 3, 4, 10, 11, 17, and 18, drawn to a method of modulating the expression of an angiogenic factor encoding gene in a cell and modulating angiogenesis in a host and inhibiting tumor growth via an agent that inhibits phosphorylation of NF-ATc, classifiable in class 514, subclass 2.
- II. Claims 5, 12 and 19, drawn to a method of modulating the expression of an angiogenic factor encoding gene in a cell and modulating angiogenesis in a host and inhibiting tumor growth via an agent that inhibits nuclear translocation of NF-ATc, classifiable in class 514, subclass 2.
- III. Claims 7, 14, 21, drawn to a method of modulating the expression of an angiogenic factor encoding gene in a cell and modulating angiogenesis in a host and inhibiting tumor growth via an agent that inhibits NF-ATc binding by binding to an NF-ATc binding domain, classifiable in class 514, subclass 44.
- IV. Claims 7, 14, 21, drawn to a method of modulating the expression of an angiogenic factor encoding gene in a cell and modulating angiogenesis in a host and inhibiting tumor growth via an agent that inhibits NF-ATc binding by binding to an NF-ATc partner protein binding domain, classifiable in class 514, subclass 44.
- V. Claims 22-29, drawn to a method of screening a test compound for angiogenesis modulatory activity, classified in class 435, subclass 4.

The inventions are distinct, each from the other because of the following reasons:

Inventions (I-IV) and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are different methods that are mutually exclusive. The methods of Groups I-IV are all drawn to various methods of inhibiting NF-ATc activity at various locations of a given biological pathway and the method of Group V is drawn to a method of screening for modulators of angiogenesis. The methods of the Groups I-IV all comprise or embrace method steps that include, for example, method steps of treating a disease. The different methods clearly comprise different method steps were the different method steps lead to different ends.

Inventions I-IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation. Each of the methods of Groups I-IV uses materially different inhibitor agents that act on different compounds where the different agents are not interchangeable in the different methods. For example, a compound that binds to a NF-ATc binding partner domain does not bind a NF-ATc binding domain since these domains have particular structures that will only bind to molecules with particular structures and other attributes. A molecule that binds a binding domain does not function to inhibit phosphorylation as an agent that inhibits nuclear translocation does not necessarily bind binding domains or inhibit

Art Unit: 1635

phosphorylation, for example. The different methods clearly have different modes of operation that require the use of different agents that have different chemical and biological properties.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Claims 1, 2, 8, 9, 15, and 16 link(s) inventions I-IV, and claims 6, 13, and 20 link inventions III and IV. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s), claim 1, 2, 8, 9, 15, and 16 (Groups I-IV) and claims 6, 13, and 20 (Groups III and IV). Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

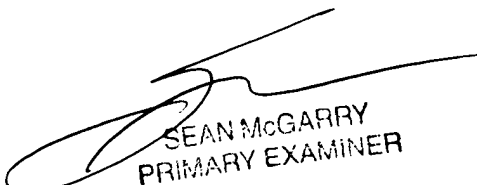
Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean R McGarry whose telephone number is (703)305-7028. The examiner can normally be reached on M-Th (6:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John LeGuyader can be reached on (703) 308-0447. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

SRM
July 30, 2003


SEAN MCGARRY
PRIMARY EXAMINER
1635